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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,680	09/19/2003	Kazutoshi Kaizuka	45144-00039	4095

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Squire, Sanders & Dempsey L.L.P.
14th Floor
801 S. Figueroa Street
Los Angeles, CA 90017-5554

EXAMINER

SAFAVI, MICHAEL

ART UNIT PAPER NUMBER

3673

DATE MAILED: 12/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/664,680

Applicant(s)

KAIZUKA, KAZUTOSHI

Examiner

M. Safavi

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5, 6 and 10 is/are allowed.
- 6) ☒ Claim(s) 1-4, 8, 9, 11, and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not identify the mailing address of each inventor. A mailing address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The mailing address should include the ZIP Code designation. The mailing address may be provided in an application data sheet or a supplemental oath or declaration. See 37 CFR 1.63(c) and 37 CFR 1.76.

It does not identify the city and either state or foreign country of residence of each inventor. The residence information may be provided on either on an application data sheet or supplemental oath or declaration.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 8 and 9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification fails to disclose a method of making a pillow involving the steps of dissolving a powder into a solution into which the

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pillow core is immersed as well as either applying the powder to the pillow core or mixing the powder with the constituent used to make the pillow core.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The language of each of claims 8 and 9 is not understood particularly since the specification fails to disclose a method of making a pillow involving the steps of dissolving a powder into a solution into which the pillow core is immersed as well as either applying the powder to the pillow core or mixing the powder with the constituent used to make the pillow core.

Claim Rejections – 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by the abstract of JP 2001-112598A to Ishii et al. (Ishii).

Ishii discloses tourmaline powder molded in a granular state with a polymer as a bonding agent wherein the molding is filled in a pillow for use. A composition of molding contains 5%-89% weight of the tourmaline powder.

Claims 1 and 11 are rejected under 35 U.S.C. 102(a) as being anticipated by the abstract of JP 2003-227282 to Noh.

Noh discloses a pillow filler containing tourmaline material. The tourmaline material is made by mixing 2% to 5% weight of tourmaline particles with a synthetic raw resin material.

Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by the abstract of JP 02003000399A to Suzuki et al. (Suzuki).

Suzuki discloses a pillow containing tourmaline powder, (means for emitting anions), mixed into at least any one of the pillow core body, the cover member and the cover material.

Claim Rejections – 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over the abstract of JP 02003000399A to Suzuki et al. (Suzuki) in view of U.S. Patent No. 5,787,525 to Sugihara et al.

With respect to claim 1, Suzuki discloses a pillow containing tourmaline powder mixed into at least any one of the pillow core body, the cover member and the cover material. However, Suzuki fails to disclose the specific amount of pillow core containing tourmaline powder of about 0.2% to 5% weight of the pillow core.

Sugihara discloses a layered fabric mattress formed from fibers containing very fine particles of tourmaline in the range of 0.05 to 7% by weight based on the unloaded fibers, preferably 0.05 to 2% by weight. Sugihara further discloses, at col. 3, lines 29-43, that "[w]hen the amount of the tourmaline particles is too small, the amount of active electrons emitted from the fibers would be too small so that the desired advantages in the present invention can not be accomplished...while no particular additional advantages can be obtained by increasing the amount thereof to exceed the above mentioned upper limit rather with an economical disadvantage along with a decrease in the fiber strength." Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the pillow core with tourmaline powder of about 0.2 to 5% weight so as to provide optimal results.

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As concerns claims 2 and 12, Suzuki discloses that, in addition to tourmaline powder, zirconium compounds are also used. Sugihara further discloses that besides the tourmaline particles, the fibers are incorporated with fine particles of other inorganic materials such as alumina, magnesia, zirconia and the like known as far-infrared emitting material. (col. 3, lines 44-54) Therefore, Sugihara teaches that zirconia and alumina and magnesia are equivalent materials, and thus the substitution of alumina or magnesia for zirconium would have been within the knowledge of one skilled in the art.

As concerns claim 4, Suzuki also discloses a covering layer (2) surrounding an inner body (3).

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki in view of Sugihara as applied to claims 1, 2, 4, 11, and 12 above, respectively, and further in view of the abstract to JP 2003-010022.

Suzuki, as modified, discloses the claimed invention except for a magnet in the pillow core. JP '022 discloses a pillow core comprising a magnet held at the upper surface thereof such that "[b]lood circulation of the head and shoulder periphery is promoted and activation of cell can be achieved by the magnetic action of the held magnet." Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the modified Suzuki pillow core with a magnet so as to promote blood circulation.

Claims 5, 6, and 10 are allowed.

Response to Arguments

The patentability of a claim to a product does not depend on merely a difference in its method of production, but on whether the product itself is new and unobvious. In re Pilkington, 411 F.2d 348, 192 U.S.P.Q. 145, 147 (CCPA 1969). If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the product was made by a different process. In re Fessman, 489 F.2d 742, 180 U.S.P.Q. 324 (CCPA 1974) and In re Thorpe, 777 F.2d 695, 227 U.S.P.Q. 964 (Fed. Cir. 1985). When the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. In re Brown, 450 F.2d 531, 173 U.S.P.Q. 685 (CCPA 1971). This burden is NOT discharged solely because the product was derived from a process not known in the prior art. In re Fessman, supra.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Safavi whose telephone number is (703) 308-2481. The examiner can normally be reached on Mon.-Thur., 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford can be reached on (703) 308-2978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



**MICHAEL SAFAVI
PRIMARY EXAMINER
ART UNIT 354**

M. Safavi
November 24, 2004